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**MAR 31 2006**

In re Application of  
Kian Teng Eng et al.  
Application No. 09/766,477  
Filed: January 19, 2001  
Attorney Docket No. TI-22944.2

DECISION ON PETITION  
UNDER 37 C.F.R. § 1.181

This is a decision on the petition filed June 27, 2005, under 37 C.F.R. § 1.181, requesting the Commissioner for Patents to compel the examiner to consider the request to declare an interference previously filed and declare an interference. The petition is before the Group Director of Technology Center 2800 for consideration.

The petition is DENIED.

This application was filed on January 19, 2001 and claims benefit under 35 USC 120 to application No. 09/478,917, filed on January 6, 2000, and issued as US patent No. 6,420,782 on July 16, 2002. This application was filed with claims 1-20 and 22-28, claim 21 was not presented. Pursuant to 37 CFR 1.126, claims 22-28 were renumbered as claims 21-27, respectively. A preliminary amendment was submitted on filing of the application to cancel claims 22-27, and to amend the specification to claim "priority under 35 USC § 119(e)(1) of Parent Application number 09/115,565 filed 7/14/1998 and Divisional Application number 09/478,917 filed 1/6/2000." Another preliminary amendment was filed on March 12, 2001, to reinstate claims 22-27 and cancel claims 11-20.

A first Office action was issued on March 13, 2002, wherein claims 1-10, directed to an integrated circuit package, were rejected under the judicially created doctrine of obviousness double patenting, under 35 USC 102 or 35 USC 103. In response to the first Office action, applicant argued that claims 1-10 have been canceled by preliminary amendment along with claims 11-20. A second Office action was issued on August 13, 2002, wherein it was indicated that claims 1-10 and 21 were actually pending and a restriction requirement was made between claims 1-10 directed to a device and claim 21 directed to a process of manufacture which was deemed to be patentably distinct from the device claims. An election was made on August 13, 2002 to prosecute claim 21. On February 11, 2003, an Office action was issued and elected claim 21 was rejected as unpatentable under 35 USC 102(e) and non-elected claims 1-10 were

withdrawn from consideration. In response, an amendment was filed on March 14, 2003, to cancel claims 1-20 and amend claim 21 resulting in claims 21-27 being pending for consideration. A supplemental response was filed to cancel claims 1-10 and re-present claims 21-27. A non-final Office action was issued on August 18, 2003 rejecting claims 21-27 as unpatentable over various grounds. An amendment was filed on September 22, 2003 amending claims 21 and 22 and presenting new claim 28. A Final Office action was issued on January 15, 2004, to finally reject claims 21-28 as being unpatentable over the prior art.

An amendment after final rejection was filed on March 3, 2004, to amend claims 21, 22 and 27, cancel claim 26, and add claims 29-35. Claims 29-35 were claims 1-6 and 9, respectively, of US patent No. 6,418,033 issued to Rinne on July 9, 2002, that were copied to provoke an interference. The effective filing date of the Rinne patent is November 16, 2000. A further amendment was filed on March 8, 2004 to add new claim 36 that was indicated as being a copy of claim 58 of the Rinne patent. No action was issued by the Office regarding the status of the two amendments filed after final rejection. A Request for Continued Examination (RCE) was filed on April 19, 2004 along with the request for entry of the amendments filed after final rejection.

On November 2, 2004, a non-final Office action was issued wherein claims 29-36 were withdrawn from consideration because they were directed to product that is deemed to be patentably distinct from the process claimed in claims 21-25, 27 and 28 and examined prior to the filing of the RCE. The invention directed toward the process was held to have been constructively elected by original presentation claims for prosecution on the merits and claims to the product were withdrawn from consideration as being directed to a non-elected invention. Elected claims 21-25, 27 and 28 were rejected as being unpatentable under 35 USC 102(b). The Office action indicated that an interference proceeding could not properly be instituted at that time.

MPEP 2303 states as follows:

“37 CFR 41.102. Completion of examination.

Before a contested case is initiated, except as the Board may otherwise authorize, for each involved

application and patent:

- (a) Examination or reexamination must be completed, and
- (b) There must be at least one claim that:
  - (1) Is patentable but for a judgment in the contested case, and
  - (2) Would be involved in the contested case.

An interference should rarely be suggested until examination is completed on all other issues. Each pending claim must be allowed, finally rejected, or canceled. Any appeal from a final rejection must be completed, including any judicial review. Any petition must be decided.

Example 1

An applicant has one allowed claim directed to invention A, which is the same invention of another inventor within the meaning of 35 U.S.C. 102(g)(1), and has rejected claims directed to different invention B. If the rejection is contested, the

application is not yet ready for an interference. Restriction of the application to invention A, followed by cancellation of the claims directed to invention B would remove this impediment to declaring an interference.

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Ordinarily restrictions are limited to situations where (A) the inventions are independent or distinct as claimed, and (B) there would be a serious burden on the examiner if restriction is not required (see MPEP § 803). Potential interferences present an additional situation in which a restriction requirement may be appropriate. Specifically, restriction of interfering claims from non-interfering claims, or from unpatentable claims whose further prosecution would unduly delay initiation of an interference, can be an appropriate use of restrictions under 35 U.S.C. 121. An Interference Practice Specialist (IPS) should be consulted in making and resolving restrictions under this heading. An applicant may, of course, also choose to cancel claims and refile them in a continuation application without waiting for the restriction requirement."

As indicated in the above-quoted passages of the MPEP, an interference may not be suggested until examination is completed. In this instance, petitioner elected to have examined the claims directed to a process instead of the claims directed to product which include the copied claims for interference. The elected process claims have not been determined to be patentable over the prior art by the examiner and the non-elected product claims have not been examined. Accordingly, examination of the claims in this application is not completed.

Because the examination of the claims in the instant application is not complete, a suggestion of interference to the Board of Patent Appeals and Interference (BPAI) is premature at this time. As such, the petition to compel the examiner to suggest an interference to the BPAI cannot be granted.

Petitioner may wish to consider presenting the copied claims in a continuing application for examination and consideration for interference.

The examiner will review the application and take appropriate action.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.



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